

1 The opinion in support of the decision being entered today was *not* written  
2 for publication in and is *not* binding precedent of the Board.

3  
4 UNITED STATES PATENT AND TRADEMARK OFFICE

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6  
7 BEFORE THE BOARD OF PATENT APPEALS  
8 AND INTERFERENCES  
9

10  
11 *Ex parte* BRIAN J. BROWN, STEVEN L. WEBB, JERLYN R. CULP,  
12 MIKE A. FARRELL, and KIMBERLY A. BITNER  
13

14  
15 Appeal 2007-0728  
16 Application 09/954,796  
17 Technology Center 2100  
18

19  
20 Decided: April 23, 2007  
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23 Before STUART S. LEVY, LINDA E. HORNER, and ANTON W. FETTING,  
24 *Administrative Patent Judges.*

25 FETTING, *Administrative Patent Judge.*

26 DECISION ON APPEAL  
27

28  
29 STATEMENT OF CASE

30 This appeal from the Examiner's rejection of claims 1-44, the only claims  
31 pending in this application, arises under 35 U.S.C. § 134. We have jurisdiction  
32 over the appeal pursuant to 35 U.S.C. § 6.

33 We AFFIRM and ENTER A NEW GROUND OF REJECTION UNDER  
34 37 C.F.R. § 41.50(b).

The Appellants invented a way to distribute software (Specification 1). An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method for distributing software, comprising:  
querying a user as to the needs of the user;  
receiving user responses to the query;  
characterizing the use of the user based upon the user responses; and  
providing software programs that may be beneficial to the user based upon the characterization of the use.

This appeal arises from the Examiner's Final Rejection, mailed November 2, 2005. The Appellants filed an Appeal Brief in support of the appeal on April 3, 2006, and the Examiner mailed an Examiner's Answer to the Appeal Brief on June 14, 2006. A Reply Brief was filed on August 18, 2006.

## PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Parthesarathy      US 6,353,926 B1    Mar. 5, 2002  
(Jul. 15, 1998)

Bradford US 6,678,679 B1 Jan. 13, 2004  
(Oct. 10, 2000)

Himmel US 6,742,052 B2 May 25, 2004  
(Aug. 9, 2001)

Kroening US 6,859,924 B1 Feb. 22, 2005  
(Dec. 12, 2000)

REJECTIONS

Claims 1, 4, 5, 7-12, 14-20, 25-36, 38, 40, and 42<sup>1</sup> stand rejected under 35 U.S.C. § 102(e) as anticipated by Parthesarathy.

Claims 2, 37, 39, and 41 stand rejected under 35 U.S.C. § 103(a) as obvious over Parthesarathy and Bradford.

Claims 6, 13, and 19 stand rejected under 35 U.S.C. § 103(a) as obvious over Parthesarathy and Kroening.

Claims 3, 21-24, and 44<sup>2</sup> stand rejected under 35 U.S.C. § 103(a) as obvious over Parthesarathy and Himmel.

Claim 43 stands rejected under 35 U.S.C. § 103(a) as obvious over Parthesarathy, Himmel, and Bradford.

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<sup>1</sup> Although claims 38, 40 and 42 are not included in the nominal recitation of the statutory rejection (Answer 5), they are included in the analysis of this rejection under 35 U.S.C. § 102(e) (Answer 15-16; Final Rejection 13), and acknowledged by the Appellants (Br. 8).

<sup>2</sup> Although claim 44 is not included in the nominal recitation of the statutory rejection (Answer 18), it is included in the analysis of this rejection under 35 U.S.C. § 103 (Answer 21-22; Final Rejection 19), and acknowledged by the Appellants (Br. 18).

## ISSUES

The issues pertinent to this appeal are

- Claims 1, 4, 5, 7-9, and 38 (Br. 10-12)
  - Whether the art applied shows characterizing the use of the user based upon the user responses.
  - Whether the art applied shows providing software programs that may be beneficial to the user based upon the characterization of the use.
  - Whether the art applied shows querying a user as to the needs of the user.
- Claims 10-12, 14-16, and 40 (Br. 12-13)
  - Whether the art applied shows means for querying a user as to the needs of the user.
  - Whether the art applied shows means for characterizing the use of the user based upon the user responses.
  - Whether the art applied shows means for providing software programs that may be beneficial to the user based upon the characterization of the use.
  - Whether the art applied shows downloading from a storage medium read by the computing device.

1       • Claims 17-20 and 42 (Br. 13-14)

- 2           ○ Whether the art applied shows logic configured to query a user as to  
3           the needs of the user.
- 4           ○ Whether the art applied shows logic configured to characterize the use  
5           of the user based upon the user responses.
- 6           ○ Whether the art applied shows logic configured to provide software  
7           programs that may be beneficial to the user based upon the  
8           characterization of the use.
- 9           ○ Whether the art applied shows logic configured to suggest an  
10          alternative selection in response to receipt of a user selection that  
11          identifies a software program the user already possesses.

12       • Claims 25-28 (Br. 14)

- 13           ○ Whether the art applied shows querying a user as to what the user  
14           wants to accomplish.
- 15           ○ Whether the art applied shows providing software programs based  
16           upon the user responses.

17       • Claims 29-32 (Br. 14-15)

- 18           ○ Whether the art applied shows querying a user as to the needs of the  
19           user.
- 20           ○ Whether the art applied shows suggesting software programs based  
21           upon the user responses.

1  
2     • Claims 33-36 (Br. 15-16)

3             ○ Whether the art applied shows determining tasks a user wishes to  
4               accomplish from responses provided by the user.

5             ○ Whether the art applied shows installing software programs based  
6               upon the determination.

7     • Claims 2, 37, 39, and 41 (Br. 16-17)

8             ○ Whether there is motivation to combine the art applied.

9     • Claims 6, 13, and 19 (Br. 17)

10            ○ Whether the art applied shows suggesting an alternative in response to  
11              receipt of a user selection that identifies a software program the user  
12              already possesses.

13    • Claims 3, 21-24, and 44 (Br. 18-19)

14            ○ Whether the art applied shows querying the user as to how the user  
15              plans to use a peripheral device (claim 3).

16            ○ Whether the art applied shows querying a user as to what the  
17              peripheral device may be used for (claim 21).

18    • Claim 43 (Br. 19-20)

19            ○ Whether the art applied shows querying a user as to what the  
20              peripheral device may be used for.

FACTS PERTINENT TO THE ISSUES

The following Findings of Fact (FF), supported by a preponderance of substantial evidence, are pertinent to the above issues.

01. Parthesarathy describes one of its claimed inventions as

A method for updating software, comprising the steps of:  
installing software on a local computer;  
creating a shortcut link for launching the installed software, wherein said installed software is identified in the shortcut link by version data;  
subscribing to a software update channel;  
detecting through said software update channel that a new software update is available on a remote computer;  
recording data relating to said new software update on said local computer, wherein said data comprises new version data;  
comparing said version data stored in said shortcut link with version data from said new software update when said installed software is launched using said shortcut link; and  
updating said installed software when said new version data is more current than said version data stored in said shortcut link  
... further comprising:  
notifying a user that the new software update is available; and  
querying the user to determine whether the user desires to load the new software update, wherein said updating of the installed software is performed when, in response to the querying step, the user indicates a desire to load the new software update.

(Parthesarathy, Claim 10, rewritten as it would appear in independent form).

02. A need is something required or wanted<sup>3</sup>.

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<sup>3</sup> American Heritage Dictionary (4<sup>th</sup> ed. 2000).

- 1 03. Thus, Parthesarathy shows querying a user as to the needs of the user, i.e.,  
2 whether the user desires to load a new software update.
- 3 04. To characterize is to describe the qualities or peculiarities of<sup>4</sup>.
- 4 05. To determine whether the user desires to load the new software update is to  
5 describe the qualities or peculiarities of the user's desires.
- 6 06. Thus, Parthesarathy shows characterizing the use of the user based upon the  
7 user responses.
- 8 07. Updating of the installed software performed when, in response to the  
9 querying step, the user indicates a desire to load the new software update is a  
10 provision of a software program that may be beneficial to the user based on  
11 the characterization of the user's desires.
- 12 08. Thus, Parthesarathy shows providing software programs that may be  
13 beneficial to the user based upon the characterization of the use.
- 14 09. Parthesarathy shows that its software is distributed over a network  
15 (Parthesarathy, col. 1, ll. 35-40).
- 16 10. Software is distributed over a network from a network server that contains a  
17 storage medium for the software to the requesting computing device. Such  
18 distribution is colloquially referred to as downloading.
- 19 11. Thus, Parthesarathy shows downloading from a storage medium read by the  
20 computing device.

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<sup>4</sup> See *supra*, note 3.



1 12. The Examiner admits that Parthesarathy alone does not show an alternative  
2 selection in response to receipt of a user selection that identifies a software  
3 program the user already possesses (Answer 18).

4 13. The Examiner has provided no support for a rejection of claim 19 over  
5 Parthesarathy alone.

6 14. Thus, we cannot say that Parthesarathy alone shows an alternative selection  
7 in response to receipt of a user selection that identifies a software program  
8 the user already possesses.

9 15. Parthesarathy shows a software application querying a user whether the user  
10 wants to load a new software update now, later, or never (Parthesarathy, col.  
11 6, ll. 15-20).

12 16. To accomplish is to complete<sup>5</sup>.

13 17. To load a new software update is to complete the updating of the software,  
14 or to accomplish the updating.

15 18. Thus, Parthesarathy shows querying a user as to what the user wants to  
16 accomplish.

17 19. Parthesarathy shows that if the user wants to accomplish a software update,  
18 the software update is loaded (Parthesarathy, col. 6, ll. 23-26).

19 20. Thus, Parthesarathy shows providing software programs based upon the user  
20 responses.

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<sup>5</sup> See *supra*, note 3.

- 1 21. Parthesarathy shows sending email notifications of software updates for  
2 distribution following the user's subscription to such updates (Parthesarathy,  
3 col. 2, ll. 16-22).
- 4 22. Such emails that the user may respond to are suggestions of software  
5 programs to be loaded based upon the user's responses in the subscription.
- 6 23. Thus, Parthesarathy shows suggesting software programs based upon the  
7 user responses.
- 8 24. Parthesarathy teaches a method to automate software update distribution  
9 (Parthesarathy, col. 2, ll. 2-7).
- 10 25. Bradford teaches methods to refine queries, such as those of Parthesarathy  
11 (Bradford, col. 1, ll. 10-16).
- 12 26. Himmel teaches a way to connect two devices with a wireless bus, that  
13 requires system configuration, which in turn requires software distribution  
14 according to the configuration. (Himmel, col. 1, ll. 6-10; col. 2, l. 66 – col. 3,  
15 l. 2).
- 16 27. Kroening teaches a method for distributing software components and  
17 updates (Kroening, col. 1, ll. 40-46).
- 18 28. Thus, a person of ordinary skill in the art would have looked to combining  
19 Bradford, Kroening and Parthesarathy as implementation details of the  
20 software distribution required by Himmel's configuration setting.
- 21 29. Kroening shows presenting a user with a list of software components that  
22 have updates available (Kroening, col. 9, ll. 36-38 and Figure 4, block 420).
- 23 30. Updated software is different from the original software.

1 31. Thus, Kroening shows suggesting an alternative in response to receipt of a  
2 user selection that identifies a software program the user already possesses.

3 32. Himmel shows querying a user whether to accept and configure a peripheral  
4 device.

5 33. To accept and configure is an instance of how to use a device.

6 34. Thus, Himmel shows querying the user as to how the user plans to use a  
7 peripheral device (Himmel, col. 2, l. 66 – col. 3, l. 2).

8 35. To configure a device is to specify its context and therefore to specify what  
9 the device may be used for.

10 36. Thus, Himmel shows querying a user as to what the peripheral device may  
11 be used for.

12  
13 ANALYSIS

14 *Claims 1, 4, 5, 7-12, 14-20, 25-36, 38, 40, and 42 rejected under 35 U.S.C.*

15 *§ 102(e) as anticipated by Parthesarathy.*

16 From the above Findings of Fact, supported by a preponderance of substantial  
17 evidence, we must conclude that

- 18 • The art applied shows characterizing the use of the user based upon the user  
19 responses (FF 06).
- 20 • The art applied shows providing software programs that may be beneficial to  
21 the user based upon the characterization of the use (FF 08).
- 22 • The art applied shows querying a user as to the needs of the user (FF 03).

- 1       • The art applied shows downloading from a storage medium read by the  
2       computing device (FF 11).
- 3       • The art applied shows logic configured to query a user as to the needs of the  
4       user and receive user responses to the query (FF 03).
- 5       • The art applied shows logic configured to characterize the use of the user  
6       based upon the user responses (FF 06).
- 7       • The art applied shows logic configured to provide software programs that  
8       may be beneficial to the user based upon the characterization of the use  
9       (FF 08).
- 10      • With respect to claim 19, we cannot say that Parthesarathy alone shows an  
11      alternative selection in response to receipt of a user selection that identifies a  
12      software program the user already possesses (FF 14).
- 13      • The art applied shows querying a user as to what the user wants to  
14      accomplish (FF 18).
- 15      • The art applied shows providing software programs based upon the user  
16      responses (FF 20).
- 17      • The art applied shows suggesting software programs based upon the user  
18      responses (FF 23).
- 19      • The art applied shows determining tasks a user wishes to accomplish from  
20      responses provided by the user (FF 18).
- 21      • The art applied shows installing software programs based upon the  
22      determination (FF 20).

1       The Appellants contend that Parthesarathy merely asks the user whether it is  
2       okay to download and does not characterize the use of the user (Br. 10-12; Reply  
3       Br. 2-4). Essentially, the Appellants are arguing for a more narrow construction of  
4       the term “characterizing.” However the term “characterizing” is a very broad term,  
5       meaning to describe the qualities or peculiarities of (FF04). In Parthesarathy, the  
6       system queries whether the user wants to load the update now, in the future, or  
7       never (FF15). As such, the system of Parthesarathy uses the query to obtain  
8       information on the particularities of the user’s use of the program, thereby  
9       “characterizing” the use, by determining when, and if, the user wishes to download  
10      updated software for the program. The Appellants also argue that claim 1 requires  
11      that the claimed method decide which programs would be best for the user.  
12      However, claim 1 actually requires only a determination that the program might be  
13      beneficial, which, given its user’s decision to acknowledge a desire for such a  
14      program, Parthesarathy clearly provides. Finally, as to the Appellants’ contention  
15      that characterizing means analyzing, we find no lexicographic definition in the  
16      Specification to support this assertion.

17      As to the Appellants’ contention that Parthesarathy’s files are downloaded  
18      from the Internet rather than from a storage device, the Internet relies on such  
19      storage devices as depositories of files for such download and is thus inherent in  
20      Parthesarathy’s teachings (FF11).

21      Regarding the Appellants’ contention that Parthesarathy fails to show querying  
22      what a user wants to accomplish (Br. 14; Reply Br. 8), this is no more than a  
23      species of the genus of characterizing the use which we determined was shown by  
24      Parthesarathy *supra*.

1 Accordingly we sustain the Examiner's rejection of claims 1, 4, 5, 7-12, 14-18,  
2 20, 25-36, 38, 40, and 42, but we do not sustain the rejection of claim 19 under  
3 35 U.S.C. § 102(e) as anticipated by Parthesarathy.

4  
5 *Claims 2, 37, 39, and 41 rejected under 35 U.S.C. § 103(a) as obvious over*  
6 *Parthesarathy and Bradford.*

7 From the above Findings of Fact, we must conclude that

- 8 • There is motivation to combine the art applied (FF28).

9 The Appellants look to very specific portions of Bradford in their contention  
10 regarding a lack of motivation to combine (Br. 16-17). However, Bradford teaches  
11 mechanisms to refine queries such as those posed by Parthesarathy. The  
12 Appellants contend that Bradford discloses data queries and that Parthesarathy  
13 only queries whether to load an update (Br. 16). But any query inherently is a  
14 request for data, the fact that Parthesarathy goes further and acts upon the data that  
15 is returned from its query does not negate the data that is implicitly returned for  
16 that action to take place upon. Whether the data is returned from a database or  
17 from data entry is an implementation detail. Bradford suggests that queries in  
18 general may need varying levels of specificity. Certainly, the level of query  
19 complexity of Parthesarathy Fig. 3 would suggest such a need.

20 Accordingly we sustain the Examiner's rejection of claims 2, 37, 39, and 41  
21 under 35 U.S.C. § 103(a) as obvious over Parthesarathy and Bradford.

22  
23 *Claims 6, 13, and 19 rejected under 35 U.S.C. § 103(a) as obvious over*  
24 *Parthesarathy and Kroening.*

1  
2 From the above Findings of Fact, we must conclude that

- 3 • The art applied shows suggesting an alternative in response to receipt of a  
4 user selection that identifies a software program the user already possesses  
5 (FF 31).

6 The Appellants take a more narrow construction of what a user already  
7 possesses than the claim allows (Br. 17). As we note above, if an update is  
8 available, that version of the software is an alternative program to the one that the  
9 user already possesses (FF30).

10 Accordingly we sustain the Examiner's rejection of claims 6, 13, and 19 under  
11 35 U.S.C. § 103(a) as obvious over Parthesarathy and Kroening.

12  
13 *Claims 3, 21-24, and 44 rejected under 35 U.S.C. § 103(a) as obvious over*  
14 *Parthesarathy and Himmel.*

15 From the above Findings of Fact, we must conclude that

- 16 • The art applied shows querying the user as to how the user plans to use a  
17 peripheral device (claim 3)(FF34).  
18 • The art applied shows querying a user as to what the peripheral device may  
19 be used for (claim 21)(FF36).

20 The Appellants argue for a more narrow construction of how a user plans to  
21 use and what something may be used for than the claims allow. To configure is to  
22 indicate how what is configured is to be used and what it may be used for (FF33 &  
23 35).

1 Accordingly we sustain the Examiner's rejection of claims 3, 21-24, and 44  
2 under 35 U.S.C. § 103(a) as obvious over Parthesarathy and Himmel.

3  
4 *Claim 43 rejected under 35 U.S.C. § 103(a) as obvious over Parthesarathy,*  
5 *Himmel, and Bradford.*

6 From the above Findings of Fact, we must conclude that

- 7 • The art applied shows querying a user as to what the peripheral device may  
8 be used for (FF36).

9 Accordingly we sustain the Examiner's rejection of claim 43 under 35 U.S.C.  
10 § 103(a) as obvious over Parthesarathy, Himmel, and Bradford.

11  
12 NEW GROUND OF REJECTION UNDER 37 CFR § 41.50(B)

13 Pursuant to 37 CFR § 41.50(b), we enter the following new grounds of  
14 rejection:

15 *Claims 1-20, 37- 42 are rejected under 35 U.S.C. § 112, second paragraph,*  
16 *as failing to particularly point out and distinctly claim the subject matter which the*  
17 *applicant regards as his invention.*

18 More particularly, independent claims 1, 10, and 17 have a limitation that  
19 programs that may be beneficial to the user are provided. The attribute of  
20 beneficence is totally subjective to each individual obviating any possibility of  
21 pointing out the scope of the claims with any degree of objective particularity.

22 Reference to undefined standards, regardless of whose views might  
23 influence the formation of those standards, fails to provide any direction to one



1 skilled in the art attempting to determine the scope of the claimed invention.  
2 *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 75 USPQ2d 1801 (Fed.  
3 Cir. 2005).

4 The remaining claims under this rejection depend from claims 1, 10, and 17,  
5 and therefore incorporate the same indefiniteness.

#### 6 OBSERVATIONS AND REMARKS

7 If prosecution continues, the examiner should consider whether the subject  
8 matter of claims 29 and 30 do no more than have a user respond to a query, and do  
9 not provide software, or anything else that appears to be concrete and tangible, and  
10 thus whether these claims are directed toward statutory subject matter.

#### 12 DECISION

13 To summarize, our decision is as follows:

- 14 • The rejection of claims 1, 4, 5, 7-12, 14-18, 20, 25-36, 38, 40, and 42 under  
15 35 U.S.C. § 102(e) as anticipated by Parthesarathy is sustained.
- 16 • The rejection of claim 19 under 35 U.S.C. § 102(e) as anticipated by  
17 Parthesarathy is not sustained.
- 18 • The rejection of claims 2, 37, 39, and 41 under 35 U.S.C. § 103(a) as  
19 obvious over Parthesarathy and Bradford is sustained.
- 20 • The rejection of claims 6, 13, and 19 under 35 U.S.C. § 103(a) as obvious  
21 over Parthesarathy and Kroening is sustained.
- 22 • The rejection of claims 3, 21-24, and 44 under 35 U.S.C. § 103(a) as obvious  
23 over Parthesarathy and Himmel is sustained.

- 1       • The rejection of claim 43 under 35 U.S.C. § 103(a) as obvious over  
2       Parthesarathy, Himmel, and Bradford is sustained.
- 3       • A new ground of rejection of claims 1-20, 37- 42 under 35 U.S.C. § 112,  
4       second paragraph, as failing to particularly point out and distinctly claim the  
5       subject matter which the applicant regards as his invention is made under  
6       37 C.F.R. § 41.50(b).

7

8       Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides  
9       "[a]ppellant may file a single request for rehearing within two months from the  
10      date of the original decision of the Board."

11      In addition to affirming the examiner's rejection(s) of one or more claims,  
12      this decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b)  
13      (effective September 13, 2004). 37 C.F.R. § 41.50(b) provides "[a] new ground of  
14      rejection pursuant to this paragraph shall not be considered final for judicial  
15      review."

16      37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO  
17      MONTHS FROM THE DATE OF THE DECISION, must exercise one of the  
18      following two options with respect to the new ground of rejection to avoid  
19      termination of the appeal as to the rejected claims:

20      (1) Reopen prosecution. Submit an appropriate amendment of the claims so  
21      rejected or new evidence relating to the claims so rejected, or both, and have the  
22      matter reconsidered by the examiner, in which event the proceeding will be  
23      remanded to the examiner . . . .

1           (2) Request rehearing. Request that the proceeding be reheard under § 41.52  
2 by the Board upon the same record . . . .

3           Should the appellants elect to prosecute further before the examiner pursuant to  
4 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35  
5 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of  
6 the affirmance is deferred until conclusion of the prosecution before the examiner  
7 unless, as a mere incident to the limited prosecution, the affirmed rejection is  
8 overcome.

9           If the appellants elect prosecution before the examiner and this does not  
10 result in allowance of the application, abandonment or a second appeal, this case  
11 should be returned to the Board of Patent Appeals and Interferences for final action  
12 on the affirmed rejection, including any timely request for rehearing thereof.

13           No time period for taking any subsequent action in connection with this  
14 appeal may be extended under 37 C.F.R. § 1.136(a).

15  
16                                   AFFIRMED  
17                                   and  
18                                   NEW GROUND OF REJECTION UNDER 37 C.F.R. § 41.50(b).  
19

20  
21  
22 JRG  
23  
24

Appeal 2007-0728  
Application 09/954,796

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